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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,383	09/06/2006	Reiner Fischer	2400.0190000/SRL	9640
26111	7590	08/05/2008	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.				BIANCHI, KRISTIN A
1100 NEW YORK AVENUE, N.W.			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/567,383	FISCHER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	KRISTIN BIANCHI	4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 June 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8, 10, 12-15 and 17 is/are pending in the application.  
 4a) Of the above claim(s) 6, 8, 15 and 17 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5, 7, 10, and 12-14 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 11/08/2006.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Claims 1-8, 10, 12-15, and 17 are pending in the instant application. Claims 6, 8, 15, and 17 are withdrawn for containing non-elected subject matter. Claims 1-5, 7, 10, and 12-14 are rejected.

### ***Information Disclosure Statement***

Applicant's Information Disclosure Statement, filed on November 8, 2006, was in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 and has been considered. A signed copy of form 1449 is enclosed herewith.

### ***Priority***

This application claims benefit of PCT/EP04/08639, filed on August 2, 2004. This application also claims benefit of foreign document (Germany) 10337496.5, filed on August 14, 2003. An English copy of this document has not been received, however.

### ***Restrictions/Election***

Applicant's election with traverse of Group I and the compound I-1-1 in the reply filed on June 9, 2008 is acknowledged.

The traversal is on the ground(s):

"The claims of Group I identified by the Office are directed to products, i.e., the compounds and compositions of claims 1-5, 7, 10, 12, 13 and 14. The claims of Group III identified by the Office are directed to processes of use of the product, i.e., methods for controlling animal pests, unwanted vegetation and/or unwanted microorganisms in which compounds of formula (I) are allowed to act on pests, unwanted vegetation, unwanted microorganisms and/or their habitat. Groups I and III therefore are related as products and processes for using such products, respectively. As noted, 37 C.F.R. § 1.475 (b)(2) states that a national stage application containing claims to a product and a process of use of said product will be considered to have unity of invention. Applicants therefore respectfully assert that the Groups I and III share unity of invention and the Restriction Requirement is improper."

This is not found persuasive because as stated in the lack of unity requirement mailed May 7, 2008, the claims lack unity of invention under PCT rule 13.1 and 13.2 since the technical feature corresponding to the claims, the core structure given in the lack of unity requirement, is not a special feature as it fails to define a contribution over the prior art as can be seen by, for example, US Patent No. 6,180,568. Therefore, the claims are not so linked as to form a single general inventive concept and there is a lack of unity of invention because the claims lack a special technical feature and the technical feature present fails to define a contribution over the prior art. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

The requirement is still deemed proper and is maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi *et al.* (US Patent No. 6,180,568, Jan. 30, 2001) in view of Lieb *et al.* (US 2003/0096806, May 22, 2003) and Fischer *et al.* (WO 03/045957 A1).

*Determination of the scope and contents of the prior art.*

Takahashi *et al.* discloses 4-aryl-4-substituted pyrazolidine-3,5-dione derivatives, specifically, for example, compound 40 (column 9, Table 5), which are used as effective components of a miticide, insecticide or herbicide. Takahashi *et al.* also discloses a miticide, insecticide or herbicide comprising as an effective component at least one of 4-aryl-4-substituted pyrazolidine-3,5-dione derivative of claim 1 (claim 6).

Lieb *et al.* discloses arylphenyl-substituted cyclic ketoenols, specifically when the CKE represents group 4 [0238] and Y is a substituted phenyl group [0233], which are used as pesticides and herbicides. Lieb *et al.* also discloses a method for preparing pesticides and/or herbicides characterized in that compounds of the formula (I) according to claim 1 are mixed with extenders and surfactants (claim 27).

Fischer *et al.* discloses 3-biphenyl-substituted-3-substituted-4-ketolactams and ketolactones, specifically when the Y group is a substituted aryl group (page 114, line 14), which are used as pesticides and/or microbicide and/or herbicides.

*Ascertaining the differences between prior art and instant claims.*

For example, compound 40 disclosed in Takahashi *et al.* is similar to a compound of the instant claims wherein W is hydrogen, X is chlorine, Z is hydrogen, G is chlorine, and A, D together represent C<sub>3</sub>-C<sub>5</sub>-alkanediyl. The only difference between the compounds of Takahashi *et al.* and the compounds of the instant claims is that Y in the compounds of the instant claims has to be an optionally substituted phenyl, naphthalene or thiophene group.

Lieb *et al.* and Fischer *et al.* both disclose compounds which are similar in structure, but not exact, to the compounds of the instant claims and are used for the same purpose. The compounds disclosed in these references both have an optionally substituted aryl (i.e. phenyl) or heteroaryl group in their structures where Y is located in the compounds of the instant claims.

*Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.*

To those skilled in the art at the time of the invention, it would have been obvious to take the compounds disclosed in Takahashi *et al.* and add an optionally

substituted aryl (i.e. phenyl) or heteroaryl group (i.e. where Y is located in the compounds of the instant claims) according to the compounds disclosed in Lieb *et al.* and Fischer *et al.* to arrive at the compounds of the instant application.

One of ordinary skill would be motivated to make the modification required to arrive at the instant invention with reasonable expectation of success for obtaining compounds with the same activity. The motivation to make the claimed compounds would be to make additional compounds for the quoted purpose (i.e. for use in pesticides, microbicides and/or herbicides).

It also would have been obvious to one of skill in the art at the time of the invention to carry out a process for preparing a composition[s] for controlling pests, unwanted vegetation and/or unwanted microorganisms comprising mixing a compound[s] of the formula (I) with extenders and/or surfactants since Takahashi *et al.* and Lieb *et al.* both disclose preparing pesticides and/or herbicides.

Thus, the instant claims are *prima facie* obvious over the teachings of the prior art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10, 14 and 15 of copending Application No. 10/542,513 (Feucht et al., US 2006/0160703). Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Determination of the scope and contents of claims 10, 14 and 15 of US Appl. 10/542,513

The claims are drawn to a composition comprising an active compound combination comprising (a) one or more substituted cyclic dicarbonyl compounds of formula (I) and (b) one or more compounds that improves crop plant compatibility.

Ascertaining the differences between claims 10, 14 and 15 of US Appl. 10/542,513 and the claims at issue.

The compounds used in the compositions of the instant application are anticipated by the compounds of US Appl. 10/542,513 when CDC of US Appl. 10/542,513 represents group 4 and Y represents optionally substituted phenyl and these substituents are very particularly preferred ([0102] and [0105]).

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

MPEP § 2144.08.II.A.4(c) states "... consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties". This is a "Genus-Species Guidelines" for the examination based on 35 U.S.C. 103. An analogous guideline was followed here for the analysis of obviousness-type double patenting.

The preferred embodiments suggests to one of ordinary skill to make compounds that fit into the instant genus. Thus, the instant claims are *prima facie* obvious over claims 10, 14 and 15 of copending US Appl. 10/542,513.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIN BIANCHI whose telephone number is (571)270-5232. The examiner can normally be reached on Mon-Fri 7:30-5, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed, Ph.D./  
Primary Examiner, Art Unit 1626

Kristin Bianchi  
Examiner  
Art Unit 1626

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